

REMARKS

Applicant respectfully requests reconsideration of this application in view of the foregoing amendments to the claims and the following comments.

In the Office Action mailed August 19, 2004, claims 3 and 8-11 were rejected under 35 U.S.C. § 112, second paragraph, for alleged indefiniteness. Claims 1-15 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 4,212,131 to Ross, Jr.

By this Amendment, Applicant has cancelled claim 2 and amended claims 1, 8, 11, and 12. Applicant respectfully seeks reconsideration of the claims for the reasons set forth below.

Rejection for Alleged Indefiniteness

The Examiner rejected claims 3 and 8-11 as allegedly indefinite based on an argument that "the phrase 'a diameter and height capable of holding at least one finger ring' is vague, confusion [sic] and indefinite because it has no clear meaning and also the at least one finger ring is not claimed in combination with the organizer." Office Action, page 2. Applicant is at a loss to understand what is not clear about this phrase. The phrase comprises ordinary English language words that anyone should be able to understand. Applicant requests the Examiner to explain what he believes is not clear about this simple and straightforward phrase using basic words from the English language.

With regard to the Examiner's observation that the at least one finger ring is not claimed in combination with the organizer, Applicant is at a loss to understand the point that the Examiner is trying to make. Of course the finger ring is not claimed in combination with the organizer. The invention is for an organizer, not the combination of an organizer and a finger ring or any other specific item of jewelry.

The Examiner's concern is readily answered by the case of Orthokinetics, Inc. v. Safety Travel Chairs, 806 F.2d 1565 (Fed. Cir. 1986). In that case, claim 1 defined a pediatric wheelchair and contained the limitation "wherein said front leg portion is so dimensioned as to be insertable through the space between the doorframe of an automobile and one of the seats

thereof." *Id.* at 1575. Clearly the automobile was not positively claimed with the wheelchair. The Federal Circuit held as follows:

The claims were intended to cover the use of the invention with various types of automobiles. That a particular chair on which the claims read may fit within some automobiles and not others is of no moment. The phrase "so dimensioned" is as accurate as the subject matter permits, automobiles being of various sizes. As long as those of ordinary skill in the art realized that the dimensions could be easily obtained, § 112, 2d ¶ requires nothing more. The patent law does not require that all possible lengths corresponding to the spaces in hundreds of different automobiles be listed in the patent, let alone that they be listed in the claims.

Id. at 1576. The same is true here. Applicant is allowed to refer in the claims to other objects with which the invention is designed to be used, and need not be specific about the dimensions of the other objects so long as "those of ordinary skill in the art realized that the dimensions could be easily obtained".

Accordingly, there is no basis for rejecting claims 3 or 8-11 as allegedly indefinite.

Rejection for Alleged Anticipation

The Examiner has rejected claims 1-15 as allegedly anticipated by Ross, Jr., which is entitled "High Utility Disk Toy," but which the Examiner gratuitously re-characterizes as "a disk toy/organizer (10)." In response, Applicant has cancelled claim 2 and amended claims 1, 8, 11, and 12 to add two limitations: One, the compartment or compartments referred to in the claims are sized to receive and store one or more items of jewelry, and two, the upper surface of the body or bodies referred to in the claims are generally planar. These limitations distinguish over Ross, Jr..

Although Ross, Jr. discloses a disk toy having "a series of concentric circular grooves 14a" in the upper surface of the disk (col. 3, lines 55-56), there is no explicit disclosure of the size of the grooves. Moreover, the purpose of the grooves is not to receive and store any objects, but "[a]s an educational toy, so that the flight characteristics can be observed and compared with and without surface extenders." (Col. 3, lines 52-55.) Thus, there is no reason

that anyone would interpret Ross, Jr. as disclosing grooves that are large enough to receive and store any items, much less jewelry.

In addition, Ross, Jr. does not show or suggest a generally planar upper surface for the disk toy. Instead, Ross, Jr. describes the disk hull as "concave/convex" (e.g., col. 1, line 31; col. 3, line 49), and the upper surface of the disk hull is shown as convex (e.g., FIGS. 1 and 4).

For the foregoing reasons, the claims as amended distinguish over Ross, Jr.

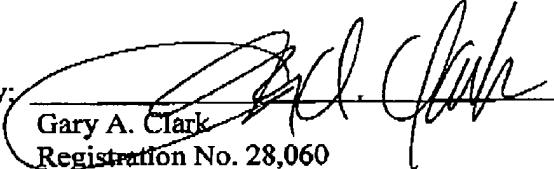
Applicant requests reconsideration and a notice of allowance.

Respectfully submitted,

SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

By:

Gary A. Clark
Registration No. 28,060



333 South Hope Street, 48th Floor
Los Angeles, California 90071
Tel.: (213) 620-1780
Fax: (213) 620-1398